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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,962

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Dudley Finch

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EXAMINER

COHEN, LEE S

ART UNIT

PAPER NUMBER

3739

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,962	<b>Applicant(s)</b> FINCH ET AL.	
	<b>Examiner</b> Lee S. Cohen	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,14-22,24,25 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-19 and 30 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,20-22,24,25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 is vague since the limitation slow implantation by the practitioner, which is not a step in the methodology.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mayer at al (4,827,940). Applicant's attention is directed to column 4, lines 45+. The reference clearly discloses the claimed structure of an electrode with a bioresorbable coating.

Claims 1, 4, 7, 8, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Parker at al (5,653,742). Applicant's attention is directed to column 3, lines 15-48. The claimed structure of a shape-memory polymer coated electrode is clearly disclosed by the

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reference. Intended use of the electrode (i.e., slow implantation into tissue) fails to patently limit the structure so as to define over the reference.

Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Madsen (6,091,979). Applicant's attention is directed to column 4, lines 19-50. The reference clearly discloses the claimed structure of an electrode with a bioresorbable coating.

Claims 21 and 27-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mojarradi et al (2004/0006264). Applicant's attention is directed to paragraph [0019]. The electrode is implanted slowly into the brain. The phrase "slowly implantable electrode" fails to impart any positive structure and can encompass that is slowly inserted by a practitioner.

Claims 21 and 27-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by He et al (2005/0021117). Applicant's attention is directed to paragraph [0026]. The electrode is implanted slowly into the brain. The phrase "slowly implantable electrode" fails to impart any positive structure and can encompass that is slowly inserted by a practitioner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 21, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al (5,653,742) in view of Mojarradi et al (2004/0006264)/ He et al (2005/0021117).

The use of MEMS technology to form the electrode structure of Parker et al would have been an obvious design expedient to the skilled artisan since it is well known as disclosed by either

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Mojarradi et al (2004/0006264)/ He et al (2005/0021117) and since a predictable result would ensue.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker at al (5,653,742) in view of Fischell et al (6,427,086). The primary reference lacks the inclusion of therapeutic material in the coating. The addition of such material to resorbable coatings is well known as shown by Fischell et al at column 35, lines 25-37. Given such a teaching, it would have been obvious to the skilled artisan to add such material to the coating of the primary reference to preclude any adverse effects of implantation. Selection of particular materials, as claimed, which are well known would have been further obvious to achieve desired effects since a predictable result would ensue.

Claims 1, 4, 7, 8, 22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gliner et al (2003/0125786) in view of Madsen (6,091,979). Gliner et al disclose the basic electrode in Figures 43A and 43B as detailed in paragraphs [0154] and [0155]. The electrode fails to include the bioresorbable coating. The use of such a coating on a similar electrode is disclosed by Madsen at column 4, lines 19-50. Given this teaching, it would have been obvious to the skilled artisan to modify the Gliner et al electrode with such a coating to more effectively implant the electrode since a predictable result would ensue.

Claims 2, 21, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gliner et al (2003/0125786) in view of Madsen (6,091,979), as detailed supra, and further in view of Mojarradi et al (2004/0006264)/ He et al (2005/0021117). The use of MEMS technology to form the electrode structure of Gliner et al would have been an obvious design expedient to

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the skilled artisan since it is well known as disclosed by either Mojarradi et al (2004/0006264)/ He et al (2005/0021117) and since a predictable result would ensue.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gliner et al (2003/0125786) in view of Madsen (6,091,979), as detailed supra, and further in view of Fischell et al (6,427,086). The combination lacks the inclusion of therapeutic material in the coating. The addition of such material to resorbable coatings is well known as shown by Fischell et al at column 35, lines 25-37. Given such a teaching, it would have been obvious to the skilled artisan to add such material to the coating to preclude any adverse effects of implantation. Selection of particular materials, as claimed, which are well known would have been further obvious to achieve desired effects since a predictable result would ensue.

#### ***Allowable Subject Matter***

Claims 14-19 and 30 are allowed.

#### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive for the reasons set forth supra. In addition, a new reference and rejections have been additionally set forth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lee S. Cohen  
Primary Examiner  
Art Unit 3739

/Lee S. Cohen/  
Primary Examiner, Art Unit 3739  
March 30, 2009